

**REMARKS**

In light of the above amendments and remarks to follow, reconsideration and allowance of this application are requested.

The specification has been amended where appropriate to correct inadvertent errors without adding new matter.

New claims 19-20 have been added and claims 1 and 4 have been amended herein. Support for the recitations of claims 1, 19 and 20 relating to embedding code markers is set forth at page 8, lines 20-26; page 11, line 14 to page 13, line 3; and Fig. 1. Accordingly, claims 1-20 are presented for consideration.

Claims 1-18 have been rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Anne Thomas, "Container-Managed Persistence," Patricia Seybold Group, December 1998 (Thomas), and further in view of U.S. Patent No. 6,601,233 (Underwood). Applicants respectfully traverse this rejection.

Thomas describes one of the automatic Enterprise JavaBeans(EJB) service, namely container-managed persistence. (Thomas, page 1, paragraph 3). However, contrary to the Examiner's assertion, Thomas does not teach or suggest a method of generating code for EJB components from a business process. Specifically, page 1, paragraph 1 and page 5, paragraph 5 of Thomas, cited by the Examiner merely describes EJB persistence mechanisms and that EJB server component model can increase developer's productivity by automating complex middleware services. Accordingly, it is respectfully submitted that Thomas does not teach or suggest "transforming each of said EJB components into EJB source code" and a method of generating code for EJB components from a business process, as required in claim 1.

Moreover, as admitted by the Examiner, Thomas does not teach or suggest "graphically modeling said business process using a UML drawing tool to provide an UML model having a plurality of EJB Classes, defining relationships between said plurality of EJB classes; and stereotyping each of said plurality of EJB classes into one or more EJB components." (Office Action, page 2, paragraph 1) To cure this fatal deficiency, the Examiner turns to Underwood.

Underwood describes a method of generating code modules from the logical business components. Underwood describes defining the logical business components and identifying the functional interrelationships between the logical business units. (col. 2, lines 5-14) However,

Underwood does not teach or suggest “embedding code markers in said EJB source code to enable subsequent updates to said EJB source code,” as required in amended claim 1.

Further, the combination of Thomas and Underwood does not teach or suggest “adding business logic code between said code markers” and “synchronizing said UML model with said business logic code, thereby providing round trip engineering support”, as required in claims 19 and 20, respectively.

Moreover, it undeniable that neither Thomas nor Underwood is even remotely concern with the problem of providing provisions for subsequent updates, synchronizing the model and code, and round trip engineering support. Since applicant has recognized a problem not addressed by the cited prior art and solved that problem in a manner not suggested by either Thomas or Underwood, the basis for patentability of the claims is established. See In re Wright, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988). There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner’s rejection. “The problem solved by the invention is always relevant”. Id. at 1962. See also, In re Rinehart, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

Absent evidence that the specific problem of providing provisions for subsequent updates, synchronizing the model and code, and round trip engineering support was even recognized by the prior art, there can be no finding that the invention as a whole would have been obvious. As stated by the PTO Board of Appeals in Ex parte Breidt and Lefevre, 161 U.S.P.Q. 767, 768 (1968), “an inventive contribution can reside as well in the recognition of a problem as in a solution”. It further appears that the conclusion reached by the Board of Appeals in Ex parte Minks, 169 U.S.P.Q. 120 (1969), is here in point. There, the Board concluded that “[a]ppellant having discovered the source of the problem and solved the same . . . he is . . . entitled to patent protection”. Id. at 121.

In view of the foregoing difference and authorities, it is submitted that the present invention now recited in independent claim 1 is patentably distinct over the combination of Thomas and Underwood. Additionally, since neither Thomas nor Underwood is even aware of the problem addressed by applicant, and since the cited prior art reference does not suggest the solution defined by claim 1, these claim are unobvious and patentably distinct over the

combination of Thomas and Underwood. Accordingly, it is requested that the rejection of claim 1-18 under 35 U.S.C. §103 be withdrawn.

New claim 19 depends from claim 1 and additionally recites the step of adding business logic code between the code markers. New claim 20 depends from claim 19 and additionally recites the step of synchronizing the UML model with the business logic code. The allowance of claims 19 and 20 is solicited for the reasons given above with respect to claim 1.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of applicant's undersigned attorney and, in the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.


Applicant's representative agrees with the Examiner's implicit finding that the prior art made of record and not relied upon is not as relevant to the claimed invention as Thomas and Underwood.

On the bases of the above amendments and remarks, reconsideration and allowance of claims 1-20 are respectfully requested.

Applicant believes no fee is due. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. **THEOR 203.1 (10107432)** from which the undersigned is authorized to draw.

Respectfully submitted,

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